



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#13
1 of 3

Appellant(s): Curtis K. Ohrt et al.
Assignee: InsWeb Corporation
Title: Dynamic Tabs For A Graphical User Interface
Serial No.: 09/534,647 Filing Date: March 23, 2000
Examiner: Le V. Nguyen Group Art Unit: 2174
Docket No.: INS0010US

Austin, Texas
November 28, 2003

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APPEAL BRIEF

Technology Center 2100

Dear Sir:

This brief is submitted in support of the appeal filed August 21, 2003 by the appellants to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-32. The appellants note that the appeal filed August 21, 2003 was received by the USPTO on August 27, 2003, thereby giving the appellant a period for filing set to expire on October 27, 2003. Filed herewith is a Petition for Extension of Time requesting a one-month extension, thereby giving the undersigned a period until November 28, 2003 (November 27, 2003 being a holiday) in which to respond.

Please charge deposit account No. 502306 for the fee of \$165.00 associated with this appeal brief. Please charge this deposit account for any additional sums which may be required to be paid as part of this appeal. This paper is submitted in triplicate.

REAL PARTY IN INTEREST

The real party in interest on this appeal is InsWeb Corporation.

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RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to this application.

STATUS OF CLAIMS

Claims 1-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gershman et al., U.S. Patent No. 6,199,099 (Gershman) in view of Torres, U.S. Patent No. 6,424,360.

STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection of April 21, 2003.

SUMMARY OF INVENTION

The invention is as set forth in the claims. To summarize the invention without intending to limit or otherwise affect the scope of the claims, the invention, as set forth by independent claim 1 and generally set forth by independent claims 9, 17, and 25, relates to a method of providing an intelligent user interface to an on-line application. A plurality of icons are furnished on a web page displayed to a user of a web browser. Each icon is a hyperlink to a dynamically generated on-line application form set, and the web browser comprises Back and Forward navigation functionalities. The dynamically generated on-line application form set is displayed in response to the activation of the hyperlink. The dynamically generated on-line application form set comprises a state determined by at least one user input. The state is maintained upon the activation of another of the plurality of icons. The maintaining allows the use of the Back and Forward navigation functionalities without loss of the state. See e.g., Figure 3, pages 8-9, and pages 12-17 of the specification.

ISSUES

The issue in this appeal is:

Whether claims 1-32 are patentable under 35 U.S.C. § 103(a) over Gershman in view of Torres.

GROUPING OF CLAIMS

For the purposes of this appeal the claims are grouped as follows:

Claims 1-32 stand or fall together.

ARGUMENT

Claims 1-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gershman et al., U.S. Patent No. 6,199,099 (Gershman) in view of Torres, U.S. Patent No. 6,424,360. The appellants respectfully traverse these rejections.

Gershman and Torres taken alone or in combination neither teach nor suggest a method of providing an intelligent user interface to an on-line application including:

furnishing a plurality of icons on a web page displayed to a user of a web browser, wherein each said icon is a hyperlink to a dynamically generated on-line application form set and wherein said web browser comprises Back and Forward navigation functionalities;

displaying said dynamically generated on-line application form set in response to the activation of said hyperlink, wherein said dynamically generated on-line application form set comprises a state determined by at least one user input; and

maintaining said state upon the activation of another said icons wherein said maintaining allows the use of said Back and Forward navigation functionalities without loss of said state,

as required by independent claim 1, and generally required by independent claims 9, 17, and 25.

Regarding the claimed “furnishing a plurality of icons . . . wherein each said icon is a hyperlink to a dynamically generated on-line application form set,” the Examiner refers to the menu selections shown in the lower left corner of Gershman’s Figure 23, and states “. . . menu selection ‘Insurance Management’ allows the user to change his/her insurance policy on-line” Office Action of August 28, 2002, p. 4, ¶1, emphasis in original. The portion of Gershman describing Figure 23 states:

FIG. 23 illustrates an agent interaction in accordance with a preferred embodiment. The agent 2310 is communicating information 2300 to a user indicating that the user’s life insurance needs have changed and pointing

the user to the chart that best summarizes the information for the user. Particular tips 2395 are provided to facilitate more detailed information based on current user statistics. A chart 2370 of the user's life insurance needs is also highlighted at the center of the display to assist the user in determining appropriate action. A button 2380 is provided to facilitate changing the policy and a set of buttons 2390 are provided to assist a user in selecting various views of the user's insurance requirements. (Column 36, line 64 through column 37, line 9).

Thus, while Gershman does show some functionality “to facilitate changing the [insurance] policy,” Gershman neither teaches nor suggests furnishing a plurality of icons . . . wherein each said icon is a hyperlink to *a dynamically generated on-line application form set*. Nothing in Gershman teaches or suggests that the web page shown in Figure 23 and/or the information associated with the Insurance Management menu selection is a dynamically generated on-line application form set or includes an icon that is a hyperlink to a dynamically generated on-line application form set. In fact, in the Office Action of August 28, 2002, the Examiner makes no attempt to point out anything in Gershman that is a dynamically generated on-line application form set.

In response to these arguments, the Examiner states in the Final Office Action of April 21, 2003, p. 6, ¶6, that:

[Gershman] teaches a dynamically generated on-line application form set wherein users fill out a form on the screen in the data fields provided wherein a menu selection links users to another on-line application form page (figs. 21-23; col. 2, lines 60-61; col. 3, lines 1-2; col. 33, lines 34-41; col. 37, lines 6-9; *menu selection “Insurance Management” displays a page that allows individual users to change his/her insurance policy on-line wherein users’ input and an interface to enter the input is inherent for the process to be completed*). (Emphasis in original)

The appellants respectfully disagree. The cited portions of Gershman do not in fact teach or suggest the claimed “furnishing a plurality of icons . . . wherein each said icon is a hyperlink to a dynamically generated on-line application form set.” The cited portions of Gershman state, respectively:

The wireless device prompts a user to input information of interest to the user.

The user may then use the hand-held device to place an order interactively utilizing a distributed communication network.

Each active User Intention also contains a number of Data Fields 1440, which contain any user data collected throughout the interaction with the user. For instance, if the user had filled out a form on the screen and one of the fields was Social Security Number, the corresponding Data Field would contain Name="SSN" 1450, Value="999-99-9999" 1460. Each User Intention also keeps track of Intention Step 1470 completion status.

A button 2380 is provided to facilitate changing the policy and a set of buttons 2390 are provided to assist a user in selecting various views of the user's insurance requirements.

This disjoint collection of references to Gershman simply does not teach or suggest: (1) Gershman's Insurance Management menu selection is a hyperlink to a dynamically generated on-line application form set (the references make no mention of the Insurance Management menu selection or any other menu selection); (2) anything else that is a hyperlink to a dynamically generated on-line application form set; or (3) the use of dynamically generated on-line application form sets generally. In fact, there is nothing in Gershman describing any attributes of the Insurance Management menu selection.

Moreover, while the Examiner's conclusion that "*wherein users' input and an interface to enter the input is inherent for the process to be completed,*" may be correct (and the appellants do not concede this point), the mere existence of an interface to "enter the input" does not teach or suggest the claimed dynamically generated on-line application form set, or more specifically the claimed *hyperlink* to a dynamically generated on-line application form set. The Examiner simply has not demonstrated that any of the on screen forms of Gershman teach or suggest a dynamically generated on-line application form set.

Regarding the claimed "maintaining said state upon the activation of another said icons wherein said maintaining allows the use of said Back and Forward navigation functionalities without loss of said state," the Examiner states:

Gershman does not explicitly describe maintaining the state upon the activation of another icon wherein maintaining it allows the use of the Back and Forward navigation functionalities without loss of the state. However, the use of the Back/Forward navigation functionalities without loss of the above mentioned state is inherent so that users may revisit a previously viewed page in its original state. (Office Action of August 28, 2002, p. 5, top, emphasis in original).

Thus, the Examiner acknowledges that Gershman does not teach or suggest the claim limitation. Instead, the Examiner suggests that the claimed maintaining said state upon the activation of another said icons wherein said maintaining allows the use of said Back and Forward navigation functionalities without loss of said state is inherent in the use of Back and Forward navigation. The appellants respectfully disagree. As noted above, the appellants' claim includes furnishing icons that are hyperlinks to *dynamically generated* on-line application form sets. While it might be the case that Back and Forward navigation of static content inherently preserves some state, i.e. the static content itself (and the appellants do not concede this point), such state information is not the appellants' claimed state information, e.g., a state of the dynamically generated on-line application form set and determined by at least one user input.

Additionally, MPEP § 2112 makes clear the fact that the Examiner *must* provide rationale or evidence tending to show inherency:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (Emphasis in Original)

The appellants respectfully submit that the Examiner has provided no such evidence or rationale tending to show inherency.

In response to these arguments, the Examiner states in the Final Office Action of April 21, 2003, p. 6, ¶7, that:

... applicant accedes that there exists an instance that the Back and Forward navigation icons function without loss of state. As long as there is an instance wherein there exists an instance when the Back and Forward navigation preserves the state, the functionality of [Gershman's] navigational icons still reads upon the claims.

The appellants respectfully disagree.

First, the Examiner has clearly mischaracterized the appellants' arguments in their Response of January 28, 2003. That Response states on page 8, ¶1:

While it might be the case that Back and Forward navigation of static content inherently preserves some state, i.e. the static content itself (*and the applicants do not concede this point*), such state information is not the applicants' claimed state information. (Emphasis Added)

There can be no clearer evidence that the appellants did not "[accede] that there exists an instance that the Back and Forward navigation icons function without loss of state," than the above quoted statement.

Second, the Examiner continues to ignore the distinction between the state maintained in the appellants' claim, i.e., a state of the dynamically generated on-line application form set and determined by at least one user input, and the arbitrary state information to which the Examiner refers. The Examiner has not demonstrated that they are one in the same, and indeed Gershman does not teach this.

Finally, the Examiner fails to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art, as required by, for example, *Ex parte Levy*. The Examiner did not establish this in the Office Action of August 28, 2002, and did not establish it in the Final Office Action of April 21, 2003.

Accordingly, the appellants respectfully submit that independent claims 1, 9, 17, and 25 are allowable over Gershman and Torres, taken alone or in combination. Claims 2-8, 10-16, 18-24, and 26-32 depend from claims 1, 9, 17, and 25 respectively and are allowable for at least this reason.

CONCLUSION

The appellants respectfully submit that claims 1-32 are allowable over Gershman and Torres taken alone or in combination. For at least the reasons stated above, claims 1-32 are allowable. The appellants respectfully request that the Board reverse the rejections of these claims.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop: Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on Nov 28, 2003.


Attorney for Appellant(s)

11/28/03
Date of Signature

Respectfully submitted,



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APPENDIX

1 1. A method of providing an intelligent user interface to an on-line application
2 comprising the steps of:
3 furnishing a plurality of icons on a web page displayed to a user of a web
4 browser, wherein each said icon is a hyperlink to a dynamically generated
5 on-line application form set and wherein said web browser comprises
6 Back and Forward navigation functionalities;
7 displaying said dynamically generated on-line application form set in response to
8 the activation of said hyperlink, wherein said dynamically generated on-
9 line application form set comprises a state determined by at least one user
10 input; and
11 maintaining said state upon the activation of another said icons wherein said
12 maintaining allows the use of said Back and Forward navigation
13 functionalities without loss of said state.

1 2. The method of Claim 1, wherein said displaying said dynamically generated
2 on-line application form set comprises combining information from a template file and
3 either a database or a conditional merge file or both to form said application form set.

1 3. The method of Claim 1, wherein said dynamically generated on-line
2 application form set comprises data and queries presented as part of a process for
3 applying for a service.

1 4. The method of Claim 3, wherein said service comprises property or casualty
2 insurance, life insurance, or health insurance.

1 5. The method of Claim 1, wherein said icons are depicted as tabs along one or
2 more inner edges of said web page.

1 6. The method of Claim 1, wherein said icons are depicted as tabs along one or
2 more inner or outer edges of a frame displayed within said web page.

1 7. The method of Claim 1, wherein said web page comprises quasi-static
2 elements distinct from said dynamically generated on-line application form set, wherein
3 said displaying said dynamically generated on-line application form set in response to the
4 activation of said hyperlink may affect the display of said quasi-static elements.

1 8. The method of Claim 1, wherein said plurality of icons displayed on said web
2 page is determined in part by said user input.

1 9. A computer system for providing an intelligent user interface to an on-line
2 application, comprising computer instructions for:
3 furnishing a plurality of icons on a web page displayed to a user of a web
4 browser, wherein each said icon is a hyperlink to a dynamically generated
5 on-line application form set and wherein said web browser comprises
6 Back and Forward navigation functionalities;
7 displaying said dynamically generated on-line application form set in response to
8 the activation of said hyperlink, wherein said dynamically generated on-
9 line application form set comprises a state determined by at least one user
10 input; and
11 maintaining said state upon the activation of another said icons wherein said
12 maintaining allows the use of said Back and Forward navigation
13 functionalities without loss of said state.

1 10. The computer system of Claim 9, wherein said displaying said dynamically
2 generated on-line application form set comprises combining information from a template
3 file and either a database or a conditional merge file or both to form said application form
4 set.

1 11. The computer system of Claim 9, wherein said dynamically generated on-line
2 application form set comprises data and queries presented as part of a process for
3 applying for a service.

1 12. The computer system of Claim 11, wherein said service comprises property
2 or casualty insurance, life insurance, or health insurance.

1 13. The computer system of Claim 9, wherein said icons are depicted as tabs
2 along one or more inner edges of said web page.

1 14. The computer system of Claim 9, wherein said icons are depicted as tabs
2 along one or more inner or outer edges of a frame displayed within said web page.

1 15. The computer system of Claim 9, wherein said web page comprises quasi-
2 static elements distinct from said dynamically generated on-line application form set,
3 wherein said displaying said dynamically generated on-line application form set in
4 response to the activation of said hyperlink may affect the display of said quasi-static
5 elements.

1 16. The computer system of Claim 9, wherein said plurality of icons displayed
2 on said web page is determined in part by said user input.

1 17. A computer-readable storage medium, comprising computer instructions for:
2 furnishing a plurality of icons on a web page displayed to a user of a web
3 browser, wherein each said icon is a hyperlink to a dynamically generated
4 on-line application form set and wherein said web browser comprises
5 Back and Forward navigation functionalities;
6 displaying said dynamically generated on-line application form set in response to
7 the activation of said hyperlink, wherein said dynamically generated on-
8 line application form set comprises a state determined by at least one user
9 input; and
10 maintaining said state upon the activation of another said icons wherein said
11 maintaining allows the use of said Back and Forward navigation
12 functionalities without loss of said state.

1 18. The computer-readable storage medium of Claim 17, wherein said displaying
2 said dynamically generated on-line application form set comprises combining
3 information from a template file and either a database or a conditional merge file or both
4 to form said application form set.

1 19. The computer-readable storage medium of Claim 17, wherein said
2 dynamically generated on-line application form set comprises data and queries presented
3 as part of a process for applying for a service.

1 20. The computer-readable storage medium of Claim 19, wherein said service
2 comprises property or casualty insurance, life insurance, or health insurance.

1 21. The computer-readable storage medium of Claim 17, wherein said icons are
2 depicted as tabs along one or more inner edges of said web page.

1 22. The computer-readable storage medium of Claim 17, wherein said icons are
2 depicted as tabs along one or more inner or outer edges of a frame displayed within said
3 web page.

1 23. The computer-readable storage medium of Claim 17, wherein said web page
2 comprises quasi-static elements distinct from said dynamically generated on-line
3 application form set, wherein said displaying said dynamically generated on-line
4 application form set in response to the activation of said hyperlink may affect the display
5 of said quasi-static elements.

1 24. The computer-readable storage medium of Claim 17, wherein said plurality
2 of icons displayed on said web page is determined in part by said user input.

1 25. A computer data signal embodied in a carrier wave, comprising computer
2 instructions for:

3 furnishing a plurality of icons on a web page displayed to a user of a web
4 browser, wherein each said icon is a hyperlink to a dynamically generated
5 on-line application form set and wherein said web browser comprises
6 Back and Forward navigation functionalities;
7 displaying said dynamically generated on-line application form set in response to
8 the activation of said hyperlink, wherein said dynamically generated on-
9 line application form set comprises a state determined by at least one user
10 input; and
11 maintaining said state upon the activation of another said icons wherein said
12 maintaining allows the use of said Back and Forward navigation
13 functionalities without loss of said state.

1 26. The computer data signal of Claim 25, wherein said displaying said
2 dynamically generated on-line application form set comprises combining information
3 from a template file and either a database or a conditional merge file or both to form said
4 application form set.

1 27. The computer data signal of Claim 25, wherein said dynamically generated
2 on-line application form set comprises data and queries presented as part of a process for
3 applying for a service.

1 28. The computer data signal of Claim 27, wherein said service comprises
2 property or casualty insurance, life insurance, or health insurance.

1 29. The computer data signal of Claim 25, wherein said icons are depicted as tabs
2 along one or more inner edges of said web page.

1 30. The computer data signal of Claim 25, wherein said icons are depicted as tabs
2 along one or more inner or outer edges of a frame displayed within said web page.

1 31. The computer data signal of Claim 25, wherein said web page comprises
2 quasi-static elements distinct from said dynamically generated on-line application form

3 set, wherein said displaying said dynamically generated on-line application form set in
4 response to the activation of said hyperlink may affect the display of said quasi-static
5 elements.

1 32. The computer data signal of Claim 25, wherein said plurality of icons
2 displayed on said web page is determined in part by said user input.